

## REMARKS

Claims 41-48 and 56-62 are pending in the application. Claims 41-43, 46-48, and 56-60 stand rejected under 35 USC 103(a) as unpatentable over US Patent No. 5,846,837 to Thym et al in view of US Patent No. 2,063,987 to Dreyfus. For the reasons set forth below, reconsideration of the pending application is respectfully requested.

1. Priority and Ownership of the Instantly Claimed Invention.

The instant application claims priority from German Patent Application DE 19849008.9, filed October 23, 1998. Upon information and belief, the invention was made sometime prior to December 4, 1997.

The subject matter disclosed and claimed in the instant application was owned by Boehringer Mannheim GmbH at the time the invention was made. Boehringer Mannheim was subsequently purchased by Roche Diagnostics GmbH, a wholly-owned subsidiary of F. Hoffman-LaRoche Ltd. ("Roche"), the current assignee/owner of the pending application.

2. Priority and Ownership of the Thym '837 Reference.

The cited Thym '837 reference claims priority from German Patent Application No. DE 196 29 657.9, filed July 23, 1996. The corresponding U.S. Application was filed July 21, 1997, and issued December 8, 1998. Upon information and belief, the Thym '837 referenced was first published on or after January 23, 1998.

The subject matter disclosed and claimed in the application that matured into the Thym '837 patent was owned by Boehringer Mannheim GmbH at the time that invention was made and until Boehringer Mannheim was purchased by Roche.

3. The Thym ‘837 Patent is Not a Proper §102(a) Reference.

As indicated by the facts recited above, the Thym ‘837 patent was not published and had not issued before applicant’s invention date. Accordingly, the Thym ‘837 patent is not a proper reference under 35 U.S.C.102(a), and cannot be combined with other prior art to support a rejection under 35 U.S.C. 103.

4. The Thym ‘837 Patent is Not a Proper §102(b) Reference.

As indicated by the facts recited above, the Thym ‘837 patent was not published and had not issued more than one year before applicant’s priority filing date. Accordingly, the Thym ‘837 patent is not a proper reference under 35 U.S.C.102(b), and cannot be combined with other prior art to support a rejection under 35 U.S.C. 103.

5. The Thym ‘837 Patent is Not a Proper §102(e) Reference.

To the extent the Thym ‘837 patent might be cited under 35 U.S.C. 102(e), the facts cited above show that the instantly claimed invention and the invention disclosed and claimed in U.S. Patent No. 5,846,837 to Thym et al. were entirely and wholly owned by the same person, organization, or business entity at the time the instantly claimed invention was made. In particular, the instantly claimed invention and the invention disclosed and claimed in Thym ‘837 were both entirely owned by Boehringer Mannheim GmbH at the time the instantly claimed invention was made.

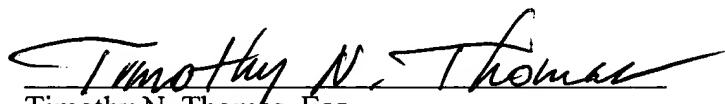
Accordingly, as provided by 35 U.S.C. 103(c), it is respectfully submitted that the Thym ‘837 reference is not a proper reference under 35 U.S.C.102(e), and cannot be combined with other prior art to support a rejection under 35 U.S.C. 103.

6. Rejection Under 35 U.S.C. 103.

The rejection under 35 U.S.C. 103 is based on Thym '837 in view of Dreyfus '987. Since Thym '837 is not prior art under 35 U.S.C. 102(a), 102(b), or 102(e), the rejection under 35 U.S.C. 103 should be withdrawn.

Reconsideration of the pending application is respectfully requested.

Respectfully submitted,

  
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